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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

THEIN, MARIA TERESA T

ART UNIT PAPER NUMBER

3625

DATE MAILED: 10/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/648,581

Applicant(s)

BIRCH ET AL.

Examiner

Marissa Thein

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Response to Amendment

Applicant's "Amendment B and Response after Final Rejection" filed on February 24, 2004 has been considered.

Claims 1 and 12 are amended. Claims 1-29 remain pending and an action on the merits of these claims follows.

Response to Arguments

In view of the Appeal Brief filed on June 28, 2004, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1-22 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S.

Patent No. 5,331,546 to Webber et al.

Regarding claim 1, Webber discloses a computer-implemented method of matching an offer for a product with a quote (col. 8, lines 28-33) comprising:

- receiving the offer from a customer machine (see at least col. 1, lines 32-49; col. 2, lines 60-col. 3, line 6; col. 4, lines 19-50);
- obtaining at least one quote for the product from a first preferred provider in a group of preferred providers (see at least col. col. 2, line 60 – col. 3, line 6; col. 4, lines 19-50; col. 6, lines 46-66; col. 7, line 53-col. 8, line 2);

Regarding claim 1, lines 7-22, the Examiner notes that there are multiple alternatives couched in “if/then” phraseology. The Examiner notes that the Courts have held “When a claim covers several structures or composites, either generically or as alternatives, the claim is deemed anticipated if any of the structures or composition within the scope of the claim is known in the prior art”. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 58 USPQ2d 1286 (Fed. Cir. 2001); *Brown v. Air Products and chemicals Inc.*, (Fed. Cir., No. 00-1552, 9/18/01). Nonetheless, in the instant case, the Examiner notes that Webber et al. discloses each and every alternative limitation set forth in the claims, as follows:

- evaluating the one quote to determine if the quote satisfies the offer (see at least col. 4, lines 19-50; col. 6, lines 46-66; col. 9, lines 17-30).
- if at least the one quote from the selected preferred provider does not satisfy offer, repeatedly: selecting another preferred provider form the group of preferred

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providers; and obtaining at least one quote for the product from the selected preferred provider; evaluating the at least one quote from the selected preferred provider to determine if the least one quote satisfies the offer; and until the offer is satisfied is exhausted (see at least col. 7, line 53 – col. 8, line 2; col. 13, lines 22-col. 14, line 26);

- if the group of preferred providers is exhausted without satisfying the offer, attempting to satisfy the offer from a group of non-preferred providers (see at least col. 10, line 62 – col. 11, line 26; col. 14, line 27 – col. 15, line 30; col. 18, lines 34-49); and
- If the offer is satisfied from either group, negotiating the purchase of the product from the provider associated with the satisfying quote (see at least col. 16, lines 56-col. 17, line 15).

Regarding claims 2-3, Webber discloses wherein attempting to satisfy the offer from the group of non-preferred providers comprises: obtaining at least one quote; evaluating the one quote to determine a most competitive quote; if the most competitive non-preferred quote can satisfy the offer, selecting the most competitive quote as the satisfying quote; and the most competitive non-preferred quote includes the lowest quote provided by a non-preferred provider (see at least col. 7, line 53 – col. 8, line 2; col. 10, line 62 – col. 11, line 26; col. 13, line 22 – col. 14, line 26; col. 14, lines 37-49; col. 15, lines 19-30; col. 18, lines 34-49).

Regarding claims 4-11, Webber discloses the product is a travel service such as airfare (see at least col. 2, lines 60-62; col. 3, lines 7-14); evaluating the quotes

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provided by the preferred providers in descending order of value, from highest quote to the lowest quote, and selecting the highest quote that satisfies the offer (see at least col. 6, lines 61-64; col.7, line 53 – col. 8, line 2; col. 11, lines 27-31; col. 15, lines 17-30); negotiation the purchase for the product which includes making a reservation (see at least col. 16, lines 56-col. 17, line 15); a global distribution system (see at least col. 3, lines 7-25; col. 5, lines 22-50); wherein each preferred provider includes a respective associated preferred criteria, and the quote satisfies the preferred criteria (see at least col. 7, line 53 – col. 8, line 2; col. 13, lines 22-col. 14, line 26); wherein attempting to satisfy the offer from the group of non-preferred providers comprises evaluating offers from the preferred providers that do not meet the preferred criteria (see at least col. 7, line 53 – col. 8, line 2; col. 10, line 62 – col. 11, line 26; col. 13, line 22 – col. 14, line 26; col. 14, lines 37-49; col. 15, lines 19-30; col. 18, lines 34-49); and a computer readable-medium (see at least col. 3, lines 7-25).

Regarding claims 12, Webber discloses a computer-readable medium having instructions comprising: receiving from a customer an offer representing a value that the customer is willing to exchange (see at least col. 4, lines 19-50; col. 6, lines 46-66; col. 9, lines 17-30); ranking each preferred provider in a plurality of preferred providers according to a preferred criteria (see at least col. 6, lines 61-64; col.7, line 53 – col. 8, line 2; col. 11, lines 27-31; col. 15, lines 17-30); selecting a highest ranked preferred provider (see at least col. 6, lines 61-64; col.7, line 53 – col. 8, line 2; col. 11, lines 27-31; col. 15, lines 17-30); and attempting to match the from the customer with the highest

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ranked preferred provider (see at least col. 6, lines 61-64; col.7, line 53 – col. 8, line 2; col. 11, lines 27-31; col. 13, lines 22-col. 14, line 26; col. 15, lines 17-30).

Regarding claims 13-15 and 19-22, Webber discloses negotiating a purchase of the product (see at least col. 16, lines 56-col. 17, line 15); repeatedly attempting to match the offer with other preferred providers until either the offer is matched or until the plurality of preferred providers is exhausted (see at least col. 6, lines 61-64; col.7, line 53 – col. 8, line 2; col. 11, lines 27-31; col. 13, lines 22-col. 14, line 26; col. 15, lines 17-30); wherein attempting to match the offer with is performed in descending order of the ranking associated with each preferred provider (see at least col. 6, lines 61-64; col.7, line 53 – col. 8, line 2; col. 11, lines 27-31; col. 13, lines 22-col. 14, line 26; col. 15, lines 17-30); the products includes travel service which comprises airfare (see at least col. 2, lines 60-62; col. 3, lines 7-14); a global distribution system (see at least col. 3, lines 7-25; col. 5, lines 22-50); and preferred criteria is negotiated with the preferred provider (see at least col. 16, lines 56-col. 17, line 15).

Regarding claims 16-18, Webber discloses wherein if attempting to match the offer with other preferred provider is unsuccessful, attempting to match the offer with one of a plurality of non-preferred providers (see at least col. 7, line 53 – col. 8, line 2; col. 10, line 62 – col. 11, line 26; col. 13, line 22 – col. 14, line 26; col. 14, lines 37-49; col. 15, lines 19-30; col. 18, lines 34-49); obtaining from one or more non-preferred providers a quote to provide the product, and selecting the lowest quote (see at least col. 7, line 53 – col. 8, line 2; col. 10, line 62 – col. 11, line 26; col. 13, line 22 – col. 14,

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line 26; col. 14, lines 37-49; col. 15, lines 19-30; col. 18, lines 34-49); and a global distribution system (see at least col. 3, lines 7-25; col. 5, lines 22-50).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent No. 5,331,546 to Webber et al.

Webber substantially discloses the claimed invention, however, Webber does not teach a round robin decision process based upon industry market share. The specific preferred criteria decision is found in the nonfunctional data stored in the computer-readable medium. The data of specifically deciding a preferred provider based on the round robin decision is not functionally related to the computer-executable instructions of the computer-readable medium. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to store any data in the computer-readable medium as

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shown in Webber because such data does not functionally relate to the computer-executable instructions of the computer-readable medium.

Claims 24-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,331,546 to Webber et al. in view of U.S. Patent No. 5,948,040 to DeLorme et al.

Regarding claim 24, Webber discloses a computer system for matching offer with quotes, comprising: online travel service exchanger, including a server component configured to interface with a customer machine and receive from the customer machine an offer for a product; a travel server component configured to obtain at least one quote with each provider in a plurality of providers to provide the product at a cost, the plurality comprising two groups, a preferred-provider and a non-preferred providers group; and the online travel service exchanger being further configured to attempt to match offer with each preferred provider in descending order of preference (see at least col. 3, line 7- col. 4, line 50; col. 5, lines 22-50; col. 6, line 22 – col. 7, line 3; col. 7, line 53 – col. 8, line 2).

However, Webber does not explicitly disclose a web server. Webber discloses entry devices such as personal computers and computer terminals. Each entry device communicates with a processor through a communication link or each or which can be a direct cable or some other hardwired connection or can be a device such as a modem operating under suitable communication software to connect the entry device to processor through the telephone network or through some other communication link

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(col. 5, lines 23-33). DeLorme, on the other hand, teaches a web server (col. 14, lines 43-50).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of Webber, to include the web server, as taught by DeLorme, in order to provide world wide communication.

Regarding claims 25-29, Webber discloses the online travel service exchanger is further configured to negotiate a purchase of the product from the provider selected as a match for the offer (col. 19, line 61 – col. 20, line 4; col. 20, lines 31-48); a global distribution system (col. 14, lines 9-25; col. 15, lines 30-43); wherein the online travel service exchanger is further configured to evaluate quotes provided by each preferred provider in descending order of preference in ranking by determining whether the quotes provided satisfy a preferred criteria associated with preferred provider (col. 18, line 54 – col. 19, line 54); and the exchanger is further configured to attempt to match the offer with one of the non-preferred providers (sellers making a counteroffer) by evaluating quotes supplied by the non-preferred providers to identify a lowest quote and selecting the lowest quote as the matching quote (col. 22, line 40 – col. 23, line 18).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 5,021,953 to Webber et al. discloses a travel planner system automatically construct ternaries with available seats for a traveler's trip request.

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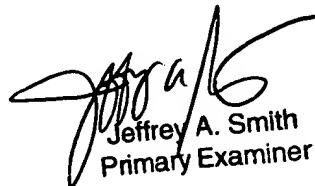
U.S. Patent No. 6,360,205 to Iyengar et al. discloses a method for providing reservation information related to airline flights.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 703-305-5246. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Smith can be reached on 703-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mtot
September 27, 2004



Jeffrey A. Smith
Primary Examiner